REMARKS:

In regard to the Examiners claim rejections under 35 USC Article 103, the Examiner has rejected claims 1 to 40 for obviousness under 35 USC 103 (a) as being unpatentable over Phanouriou et al. (Transforming Command-Line Driven Systems to Web Applications) in view of the Eager et al. (US Patent 5,960,200) and also in view Apte et al. (US Patent 6,662,236).

Notwithstanding the fact that Applicant strongly believes that the feature of <u>automatic translation</u> does not occur in Eager et al, Applicant now provides amended claims which more clearly define the claimed invention.

Firstly, Examiner is drawn to the claims as a whole, which clearly recites all the features of the original claims. However, the claim has been partially rewritten to make the claim more understandable.

The independent claims have also been amended to include the feature of the executable software components being able to interact with the scripting language to perform additional functions. This feature is generally described at, for example, page 27, lines 26-34, which describes the inclusion of 'user hooks', which allow users to have "their own code invoked... without requiring any changes to the generated client code".

None of Phanouriou, Eager or Apte teach a system which allows a user <u>to modify code</u> that affects the functionality of a system <u>without requiring any changes to the generated code</u>. Therefore, the claims, as amended, are now novel and non-obvious, even in

13

light of Phanouriou, Eager or Apte, whether taken singularly or in combination.

Notwithstanding the claim amendments made, Applicant wishes to comment on the relevance of Eager et al.

In light of the recent Supreme Court decision, [KSR International Corporation v Teleflex Incorporated] No. 041350 (US April 30, 2007), the Examiner is reminded that any analysis supporting a rejection under. 35 USC section 103 (a) should be made explicit, since it is "important to identify a reason that would have a person of ordinary skill in the relevant field to combine the [prior art] elements". This requirement is also provided in a memo dated May 3, 2007 by Margaret A. Focarino, Deputy Commissioner of the USPTO.

In the Office Action dated March 28, 2007, Examiner states that it would have been obvious for a person of ordinary skill in the arts to combine Phanouriou and Eager because Eager's system provides "a method to transition an entire enterprise to a distributed infrastructure". However, such reasoning appears to contradict another established principle when considering obviousness, namely --- that a proposed modification cannot render the prior art unsatisfactory for its intended purpose in combining this prior art with another cited reference.

In the presently claimed invention, the problem faced by a person of ordinary skill in the art is how to allow users to access a legacy application with minimal disruption and minimal reprogramming. The invention of Eager et al. provides a system and method to transition an entire enterprise to a distributed

14

infrastructure. That is, Eager teaches how to provide an entirely new computing system (i.e. both "back end" and "front end"). The provision of an entirely new infrastructure has a number of attendant disadvantages, such as requiring users to learn new user interfaces, requiring an organisation to install a new central computing system and the further requirement of moving data from the legacy system to the new system. This is in addition to the time spent in physically transitioning the entire enterprise.

Eager acknowledges that the transitioning of an entire enterprise is time and resource hungry. It is for this reason that Eager teaches, generally, a staged or multi-step transition from a legacy enterprise system to a new distributed computing model. Examiner is referred generally to column 5, lines 28 through to line 40. In this section, with reference to figure 3, Eager describes a multi-step process which includes an implementation strategy stage, a planning stage, an implementation stage and an operation stage. Eager then proceeds to describe each of these steps in more detail, including the transition of individual components across a series of steps.

Nowhere in Eager is there any suggestion that the need to transition the entire enterprise is "optional". Therefore, Eager as a whole teaches away from only transitioning certain components of an entire enterprise. The entire concept of Eager is to teach a person skilled in the art how to transition an entire enterprise.

In contrast, the Applicants claimed invention bypasses all of these attendant disadvantages by completely avoiding the step of

15

transitioning the central or centralised computing system to a new computing system. To suggest that the teaching of Eager can simply be combined with the teaching of Phanouriou is neither correct nor feasible, as a person of ordinary skill in the art would <u>not see</u> the advantage of Eager, as fundamental <u>changes</u> would need to be made to the invention of Eager in order to teach the Applicant's claimed invention.

Therefore, it is not enough for the Examiner to merely suggest that Eager provides a method to transition an entire enterprise to a distributed infrastructure, since the Applicant's claimed invention does not attempt to transition an <u>entire</u> enterprise to a distributed infrastructure. Indeed, the present invention was conceived out of a need to <u>avoid</u> transitioning an entire enterprise to a distributed infrastructure. In other words, Eager <u>teaches away</u> from the present invention.

Applicants have previously argued that (1) Phanouriou, Eager and Apte fail to teach the limitation "automatically translates Legacy source code interface specification definitions into an executable software component which may be executed on an interconnected network computing resource" --- Phanouriou teaches the GUI is generated by a person "familiar" with how to run the application.

Applicant had stated that Eager teaches "GUI files 248 are used by developers and maintenance personnel to modify application screens.

16

Applicants further stated that the reference to Apte does not teach this limitation.

Then Examiner has countered with a disagreement where Examiner indicated that as to point (1) that Eager does teach the limitation of "automatically translating Legacy source code... which may be executed by an interconnected network computing resource". Thus Examiner has stated that Eager column 23 lines 17 - 45 would indicate that Eager "teaches" the claim's limitation.

Here, Applicants would like to reiterate the comments regarding the Eager reference.

Now looking at the problem faced by a person of ordinary skill which is --- how to allow users to access a Legacy application with minimal disruption and minimal reprogramming.

Note that Eager's system and method works to retransition an "entire enterprise" to a distributed infrastructure. That is to say Eager is teaching how to provide an entirely new computing system, that is to say this includes both a "back-end", and also a "front-end".

Again Applicants would reiterate that the provision of a new infrastructure has many attendant disadvantages which require users to learn new user interfaces, which requires an organization to install a new central computing system and a requirement of moving data from the Legacy system to the new system.

17

Thus Examiner by insisting on the Eager reference as a proper teaching is going beyond the bounds of reasonableness.

When this much engineering rework and redesign is involved, it is beyond the bounds of reason to say that Eager could easily be combined with Phanouriou and Apte. Note that the entire concept of Eager is to teach the art on "how to transition an <u>entire</u> enterprise".

Applicants would reiterate that the teaching of Eager makes no sense or reason for it to be combined with the teaching of Phanouriou. One could easily see there would be no particular advantage to use the technology of Eager in Applicant's configuration.

To reiterate some of Applicant's previous arguments, it is seen that the presently claimed invention of Greenfield <u>automatically</u> <u>generates</u> the required executable software components by utilizing the original Legacy code. Thus the invention allows the interface to be built from original Legacy code <u>without the</u> <u>need</u> for any substantive input from a programmer or user.

> The term "user interface repository" of Eager clearly denotes a structure which determines the layout of the interface.   It is merely a file that contains information that is used to render particular features of a GUI. --- This is not <u>Legacy code</u>.

To quote Eager lines 66 and column 23 thru line 11 and column 24, Eager teaches that:

<center>18</center>

... GUI files 248 are used by application developers and maintenance personnel to modify application screens and messages are part of the "reengineering system 30".

Of course this indicates that any substantive changes to the graphical user interface (GUI) are performed manually by programmers.

The Examiner is basing his contentions that by combining various technologies from various cited references --- and then contends they can be combined to provide the same features that are stated in Applicant's claims --- is not a sustainable position.

In regard to the new dicta of "required reasoning" developed by the recent KSR v Teleflex decision, we should also consider the recent decision of the Board of Patent Appeals and Interferences on March 22, 2006.

We should note the case of In re KAHN, Fed Ckt 04-1616, 3/22/06, where the Board indicated that:

> an obviousness rejection must articulate the motivation, suggestion or teaching that would have led the skilled artisan at the time of the invention to combine prior art elements to make the claimed invention.

> While the absence of Teaching Suggestion Motivation (TSM) is no longer a complete requirement for obviousness --- there is still the "rule of reason".

19

The case of In re Kahn indicates that absent such an explanation (reason for motivation) we infer, said the court, that the Board used <u>hindsight</u> to conclude that the invention was obvious.

In this Kahn case, the court said ---

> to establish a prima facie case of obviousness based on a combination of prior art elements, the Board must <u>articulate</u> the basis on which it concludes it would have been obvious to make the claimed invention --- and when the Board does not explain the motivation of the suggestion or the teaching --- that would lead a skilled artisan at the time of the invention to the claimed invention as a whole, we infer that the Board used <u>hindsight</u> to conclude that the invention was obvious. (underlines added)

> Examiner is conveniently using hindsight in posing a combination of three references which are not engineerly possible to make a workable configuration. Now under the latest KSR v Teleflex situation, it is incumbent upon the Examiner to present some reason or evidence why the Eager reference should be combined with the Phanouriou reference and exactly what reason would an engineer have to take such a complicated step?

Applicants would again state that Applicant's invention does not intend to transition an <u>entire enterprise</u> to a distributed infrastructure as in Eager. Quite contrarily the present invention was made from a need to <u>avoid</u> transitioning an entire

20

enterprise to a distributed infrastructure. Again it will be seen that Eager teaches away from the features and aspects of Applicant's present invention.

It may also be noted that the newly-amended independent claims have been clarified to indicate --- the executable software components are capable of interacting with one of the scripting language or an intermediate software application in order to invoke user-provided code.

Examiner's reasoning for combining the Phanariou reference, the Eager reference and the Apte reference could not present a workable operating combination of elements which could efficiently provide for the features of Applicant's invention. In this regard it is requested the Examiner view the claims as a whole in their entirety and appreciate the differences thereof over any combination of the cited references and thereupon provide a timely Notice of Allowance therefor.

Respectfully submitted,

BY *Alfred W. Kozak*

Alfred W. Kozak
Reg No. 24,265
(949) 380-5822

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

FACSIMILE

☐ *deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.*

☑ *transmitted by facsimile to the United States Patent and Trademark Office.*

Carol A. Wasserman —May 25, 2007

Carol A. Wasserman   Date

Date: May 25, 2007

21